

REMARKS

This application has been reviewed in light of the Office Action dated November 27, 2006. Claims 1, 4, 6-13, 16 and 18-24 are presented for examination. Claims 2, 3, 5, 14, 15, 17 and 25 have been cancelled, without prejudice or disclaimer of subject matter, and will not be mentioned further. Claims 1 and 13, which are the independent claims, and Claims 6, 16 and 18-24 have been amended. Favorable reconsideration is requested.

Claims 1, 4, 6-8, 13, 16 and 18 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent 6,292,789 ("Schutzer") in view of U.S. Patent 4,321,672 ("Braun"). Claims 9-12 and 19-24 were rejected under 35 U.S.C. § 103(a) as being obvious over Schutzer and Braun, and further in view of U.S. Patent 6,098,091 ("Kisor").

Schutzer relates to a system for computerized bill presentment, including the electronic delivery of a bill from a biller to a consumer and for electronic delivery of subsequent payment from the consumer to the biller. The system includes a bill service provider that accepts and consolidates billing data from the biller, publishes the data and routes the data electronically to the appropriate consumer service provider. A consumer service provider presents the bill to the consumer. When the consumer makes a request for a bill, the consumer service provider transmits the request to the bill service provider, which then transmits the request to the biller. Once the bill service provider receives the billing data from the biller, the bill service provider may reformat the bill design and content into a standard format before routing the billing data to the consumer service provider.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion

or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2143.

Nothing has been found in Schutzer that would teach or suggest a system for executing a cash payment from a computer network comprising, among others, “request translation software operative to receive the payment request and translate the request into the native format of an ATM control server, the ATM control server being operative to generate and transmit payment instructions and a PIN code to an ATM, to enable the ATM to dispense the payment upon receipt of the PIN code [emphasis added]”, as recited in Claim 1.

The Examiner cited the abstract of Schutzer as teaching the “request translation software.” See Office Action page 3, paragraph 3. Applicants respectfully disagree. The abstract of Schutzer states that the biller account automatically formats a bill for a consumer from the bill data. The bill file from which the bill is automatically formatted includes a bill template and bill content and may also include a temporary resource. The formatted bill consists of an electronic mail message, and the storage location is an electronic mailbox. This portion of Schutzer discusses a billing process, where the bill file is formatted and provided to the consumer, *i.e.*, not a payment process. It is clearly different from a system for executing a cash payment from a computer network where the “request translation software operative to receive the payment request and translate the request into the native format of an ATM control server [emphasis added]”, as recited in Claim 1.

The Examiner also referred to Schutzer at column 27, lines 7-35, as teaching or suggesting the “request translation software.” See Office Action page 3, paragraph 3. Here, too, Applicants respectfully disagree. This portion discusses the layered approach to standards employed in the system of Schutzer. The layered approach may accommodate new evolving standards without impact on the overall architecture and system design. The standards are layered on top of one another, each independent of the choice of lower-level standards. However, Applicants submit that such portion does not teach or suggest the “request translation software operative to receive the payment request and translate the request into the native format of an ATM control server [emphasis added]” that is recited in Claim 1.

As noted in the Office Action, Schutzer does not teach an ATM control server operative to generate and transmit payment instructions and a PIN code to an ATM, thereby enabling the ATM to dispense the payment upon receipt of the PIN code, as recited in Claim 1. However, the Examiner asserted that Braun teaches such features. Applicants respectfully disagree. Braun relates to a method and system for effecting electronic funds transfer transactions based upon the use of unit records containing preprinted non-machine readable data, preprinted machine readable data, and manually entered data, and conversion of such records from negotiable instruments to documentary evidence of the satisfactory completion of the transaction. A financial institution may automatically read the encoded data on the unit record and incorporate transaction data and security information in messages transmitted from a terminal. The financial institution may thereby verify the validity of the transaction, effect the transaction and return an authorization message containing both reference and transaction information for imprinting on the unit

record. However, Braun does not teach or suggest an “ATM control server ... operative to generate and transmit payment instructions and a PIN code to an ATM, to enable the ATM to dispense the payment upon receipt of the PIN code [emphasis added]”, as recited in Claim 1.

Generally speaking, after the payment request is translated into the native format of the ATM control server, the ATM control server of Claim 1 generates and transmits payment instructions and a PIN code to an ATM. A payee subsequently enters the PIN code to the ATM and receives payment from the ATM. Braun, on the other hand, merely discusses that a PIN is entered by a customer into a terminal and stored by a microprocessor. The stored information may be transmitted by the terminal to a data processor. *See* Braun, col. 11, lns. 56-65. Braun does not teach or suggest that an ATM control server generates and transmits payment instructions and a PIN code to an ATM.

As noted above, one of the basic criteria in establishing a *prima facie* case of obviousness is that the prior art reference (or references when combined) must teach or suggest all the claim limitations. The proposed combination of Schutzer and Braun does not teach or suggest a system for executing a cash payment from a computer network comprising, among others, “request translation software operative to receive the payment request and translate the request into the native format of an ATM control server, the ATM control server being operative to generate and transmit payment instructions and a PIN code to an ATM, to enable the ATM to dispense the payment upon receipt of the PIN code”, as recited in Claim 1. Accordingly, Applicants submit that Claim 1 is patentable over Schutzer and Braun, no matter how they hypothetically may be combined.

Independent Claim 13 recites features similar to those discussed above with respect to Claim 1 and therefore is also believed to be patentable over Schutzer and Braun for the reasons discussed above.

A review of the other cited reference, i.e., Kisor, has failed to reveal anything which, in Applicants' opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the cited reference.

The other claims in this application are each dependent from one or the other of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

/Leonard P Diana/
Leonard P. Diana
Attorney for Applicants
Registration No. 29,296

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 612338v1